



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,154	03/30/2001	Robert A. Immerman	IN0191US (#90067)	6306

28672 7590 09/03/2003

D. PETER HOCHBERG CO. L.P.A.  
1940 EAST 6TH STREET  
CLEVELAND, OH 44114

EXAMINER

WOOD, KIMBERLY T

ART UNIT	PAPER NUMBER
----------	--------------

3632

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/822,154

Applicant(s)

IMMERMAN, ROBERT A.

Examiner

Kimberly T. Wood

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 11-15 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-5, 11-15 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

Art Unit: 3632

This is the fifth office action for serial number 09/822,154, Suction Cup Holder, in response to RCE filed July 17, 2003.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 11-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for first pair of horizontal wire and second pair of wires defining a generally horizontal rectangular opening, does not reasonably provide enablement for first pair of horizontal wire and second pair of wires defining a generally vertical rectangular opening. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3632

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation "rectangular opening" in line 11. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 11, 12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Raphael 3,181,702. Raphael discloses a first pair of horizontal wires (39 and 41), a second pair transverse wires (96), the wires defining a generally vertical rectangular opening (see attached figure), a suction cup with a head and a neck), two fastener arrangements (where the wires are attached to the fixture), and a fixture

Art Unit: 3632

(50, 42, 43, 51, 52, 47, 48 and 53). The horizontal wire (41) retains the neck of the suction cup (66) within the opening. The wires are attached to the fixture by welds or at least one brazing(column 2, lines 56ff, where 52 and 53 are attached to 39 and where 47 and 48 are attached to 41).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raphael 3,181,702. Raphael discloses all of the limitations of the claimed invention except for the fastener arrangement being fastened to the fixture by soldering or adhesive. The further limitation of the device being fastened to the fixture by soldering or by adhesive is a design choice and the applicant did not disclose any reason for why the device and the fixture critically had to be fastened with one of those techniques. Therefore, it would have been

Art Unit: 3632

obvious to one having ordinary skill in the art to have chosen to use the well-known techniques such as soldering or by using adhesive in order to securely fix the device to the fixture. Raphael provides motivation or suggestion for such a modification clearly in column 2, lines 54, which states "the connection preferably is by welding, although the connection may be made by brazing or by other conventional connection means".

***Allowable Subject Matter***

Claim 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the prior art does not disclose an assembly comprising in combination a fixture, a device, and a suction cup comprising a generally rectangular structure having two vertical sides, two horizontal sides and four rounded corners; at least two fastener arrangements fastening each vertical side of the rectangular structure to one parallel vertical wire so that the horizontal axis of the rectangular structure is perpendicular to the vertical wires.

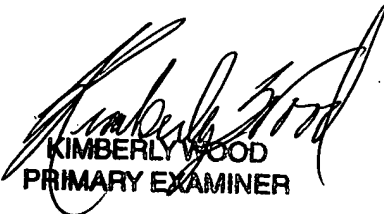
Art Unit: 3632

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Wood whose telephone number is (703) 308-0539. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168. The fax number for an Official Amendment or Response is (703) 872-9326. The fax number for an Official After Final Amendment or Response is (703) 872-9327.

Kimberly Wood  
Primary Examiner  
August 25, 2003



KIMBERLY WOOD  
PRIMARY EXAMINER

**May 4, 1965**

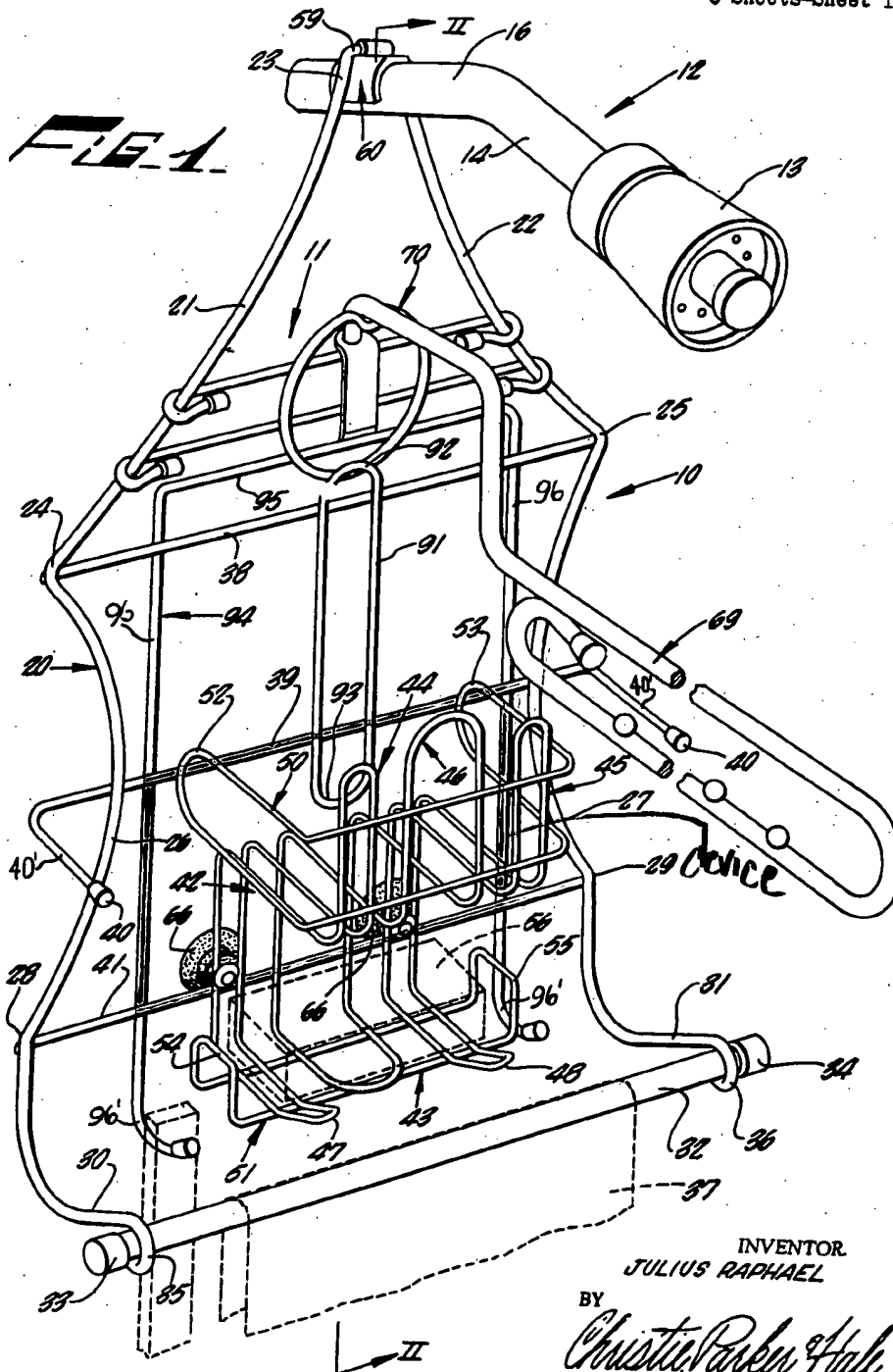
**J. RAPHAEL**

**3,181,702**

HANGER FOR USE IN COMBINATION WITH SHOWERS AND THE LIKE

Filed March 25, 1963

3 Sheets-Sheet 1



INVENTOR  
JULIUS RAPHAEL

BY

*Christie, Parker & Hall*  
ATTORNEYS.